

REMARKS

Applicant appreciates the Examiner's review of the present application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks. Claims 1-20 are pending. Claims 16-20 have been withdrawn from consideration.

Claim 2 has been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. With this amendment, Applicant has amended claim 2 to put the claim in proper form. Accordingly, Applicant respectfully submits that the objection to claim 2 has been overcome.

Claims 2, 3, 8, and 12-15 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With this amendment, Applicant has amended the claims to clarify their meaning. With respect to claim 3, the Examiner states that the phrase "a region of greater than double coverage" renders the claim indefinite. With this amendment, Applicant has cancelled this phrase. However, Applicant respectfully submits that the meaning of this

phrase is clear when read in view of the specification. See, for example, paragraph [0022] et seq. Accordingly, Applicant respectfully submits that the rejection of claims 2, 3, 8, and 12-15 under 35 U.S.C. 112, second paragraph, has been overcome.

Claims 1, 3, 4, 9, and 11-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Simpson et al. (U.S. Patent No. 5,096,759) in view of McGroarty et al. (U.S. Patent No. 5,079,088). Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Examiner has misread Simpson et al. In particular, Simpson et al. discloses two distinct inventions, a roll of roofing material 10 (FIGS. 1-4), and an underlayment 90 (FIGS. 9-11). In the Examiner's rejection of the pending claims, the Examiner has improperly combined elements from both of these distinct inventions without indicating how the Examiner is interpreting reference. For example, the Examiner refers to the following elements from the underlayment 90: impregnated mat 92 (col. 5, ll. 34-54); asphalt composition (col. 5, ll. 48-54); adhesive 94 (col. 5, ll. 48-62); and release paper 96 (col. 5, ll. 48-62). Additionally, the Examiner refers to the following elements (in the same rejection) in the roofing membrane 10: coating 24 (col. 3, ll. 25-29 and col. 4, ll. 36-

39); and aluminum foil sheet 18 (col. 3, ll. 11-19). Applicant respectfully submits that these are two distinct inventions and that it is improper to combine these two inventions as suggested by the Examiner.

While the Examiner makes not reference to the following, Applicant assumes that the Examiner is rejecting the present application over the combination of the roofing membrane 10 and the underlayment 90 when in an installed orientation since this is the only embodiment combining these two distinct inventions. However, Applicant respectfully submits that the combination of the roofing membrane 10 and the underlayment 90 does not disclose or suggest all the elements recited in independent claim 1 except the clean surface area as suggested by the Examiner.

In particular, claim 1 recites "granules adhered to said *asphalt composition* on said *decorative surface area*" and that the decorative surface area is disposed on an "upper side of said *substrate*" which is saturated with the asphalt composition. Applicant submits that neither the roofing membrane 10, the underlayment 90, nor the combination thereof, discloses these elements.

At best, the combination of the roofing membrane 10 and the

underlayment 90 discloses a layer of aluminum foil 36 bonded to the top of a polyethylene sheet 20 with an ionomer resin adhesive 22, a layer of bitumen 24 disposed on a bottom surface of the polyethylene sheet 20, and a polyester mat 92 having a bottom layer of layer of adhesive 94 disposed beneath the layer of bitumen 24.

Firstly, the aluminum foil 35 is not the same as a layer of granules. In fact, Simpson et al. teach away from the use of granules. Simpson et al. purport to disclose an improved method of shielding asphalt layers from ultraviolet light, thus solving the problems associated with the use of roofing granules. See *Background of the Invention*, Col. 1, lines 14-37. Modifying this layer of aluminum foil 36 to include a layer of granules as suggested by the Examiner would change the principal operation of Simpson et al. and render it unsatisfactory for its intended purpose.

Secondly, Applicant respectfully submits that the layer of aluminum foil 36 is not adhered to the upper surface of the asphalt saturated substrate. The Examiner states that the polyester mat 92 reads on the asphalt saturated substrate recited in independent claim 1. The layer of aluminum foil, however, is

adhered to the layer of *polyethylene sheet 20* with an ionomer resin adhesive 22. Furthermore, there is a layer of bitumen between the polyethylene sheet 20 and the polyester mat 92. Accordingly, Applicant respectfully submits that the layer of aluminum foil 36 is *not adhered* to the *upper surface* of the *asphalt saturated* substrate (i.e., the polyester mat 92) as recited in independent claim 1.

Thirdly, as the Examiner correctly states, Simpson et al. do not disclose or suggest a clean surface area disposed on the upper surface of the asphalt saturated substrate. As discussed above, upper surface of the polyester mat 92 (when combined with the roofing membrane 10) is entirely covered by the layer of bitumen 24 disposed on a bottom surface of the polyethylene sheet 20 of the roofing membrane 10. Additionally, for the reasons stated above, the layer of polyethylene sheet 20 does not read on the asphalt saturated substrate recited in independent claim 1 since the layer of polyethylene sheet 20 is not saturated with asphalt.

Accordingly, the layer of polyethylene sheet 20 cannot be modified to include a clean surface area as suggested by the Examiner.

Moreover, ignoring the fact that the layer of polyethylene

sheet 20 cannot be saturated by asphalt, Applicant respectfully submits that Simpson et al. teach away from modifying the layer of polyethylene sheet 20 to include a clean surface area on the upper surface as suggested by the Examiner. In particular, Simpson et al. disclose that the polyethylene film 20 and the aluminum foil 36 have an identical size. See col. 3, ll. 46-48. Accordingly, it is improper to modify Simpson et al. as suggested by the Examiner to include a clean surface area of the upper surface of the substrate.

For at least the above reasons, Applicant respectfully submits that Simpson et al. do not disclose or suggest all the elements recited in independent claim 1. Moreover, Applicant respectfully submits that it would be improper to modify Simpson et al. as suggested by the Examiner.

In regard to claims 12 and 13, the Examiner states that it would have been obvious to adjust the relative amounts of the asphalt, filler, oil and styrene butadiene styrene rubber. In particular, the Examiner cites *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980) for the proposition that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. Applicant

respectfully traverses this assertion.

MPEP § 2144.05 states "a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)". Applicant respectfully submits that the Examiner has not established that the particular perimeters in claims 13 and 14 are a result-effective variable.

In regard to claim 8, the Examiner states that Simpson et al. teach styrene-butadiene block copolymer in an amount of 13% by weight and that Kennepohl et al. teach that the limestone filler is present in the asphalt composition in the amount of 50% by weight of the asphalt composition and that the remainder is oxidized asphalt. The Examiner then states that minor changes in the relative amount of filler, asphalt, and rubber in an asphalt composition would be an unpatentable modification. Applicant respectfully traverses this rejection.

Applicant respectfully submits that neither Simpson et al. nor Kennepohl et al. disclose or suggest an asphalt composition including all of the elements, let alone their relative amounts.

Applicant respectfully submits that the Examiner is impermissibly combining a potpourri of elements from many different asphalt compositions recited in the above references, none of which include all of the recited elements nor the specific relative amounts. For example, Kennepohl et al. disclose, at best, an asphalt composition including a 50/50 mixture of filler and oxidized asphalt. Nowhere do Kennepohl et al. disclose the use of styrene-butadiene as recited in dependent claims. Furthermore, Simpson et al. disclose a bitumen coating having a 63% non-oxidized asphalt, 13% styrene-butadiene, 12% filler, and 7% oil. Applicant respectfully submits that the asphalt compositions disclosed in Simpson et al. and Kennepohl et al. have different compositions with different percentages.

In regards to claim 10, as previously discussed, Applicant respectfully submits that it is improper to modify the aluminum foil 36 to include a granular material because Simpson et al. specifically teach away from such a modification for the reasons stated hereinabove.


The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.



In re: Thomas Zickell
Filed: July 3, 2001
Serial No.: 09/898,707
Page 17

Respectfully submitted,

Thomas Zickell

By 
Paul J. Kroon, Jr.
Registration No. 51,902
Attorney for Applicant(s)

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: 9-22-03

RECEIVED
SEP 26 2003
TC 1700